

Application No. 09/909,288
Amendment Date January 5, 2005
Reply to Official Action (Paper No. 14) of October 5, 2004

REMARKS/ARGUMENTS

Status Of The Claims

The Second Office Action dated October 5, 2005, has been carefully considered. Claim 41 has been canceled without prejudice. Claims 38, 57, 59, and 66 have been amended to incorporate the language of canceled Claim 41. Reconsideration and allowance of all claims is respectfully requested. Claims 38-40, and 42-66 remain in the application for consideration.

Formal Matters

Claims 38-51, 53-55, and 58-66 under 35 U.S.C. 103(a) as being unpatentable over Culshaw et al (US 5,202,050) in view of JP 815197 have been withdrawn. Additionally, all other rejections using Culshaw et al as the primary reference have been withdrawn.

Rejections Under 35 U.S.C. § 112

- A. Claims 38-66 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Office Action asserted that the specification, as originally filed, provided no basis for a pH being "greater than 11" although it admits there is basis for a pH of 11.5. Claims 38, 57, 59, and 66 have been amended to remove the phrase "greater than 11" and insert the term "about 11.5" in the pH range cited. Accordingly, reconsideration and withdrawal of the 112 rejection is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

- A. Claims 38-55 and 57-66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Feng (U.S. Patent 5,929,007) in view of Culshaw et al (U.S. Patent 5,202,050) (hereinafter referred to as "Culshaw et al") and Japanese reference JP 8-151597 (hereinafter referred to as "JP '597").

The Office Action asserted that Feng discloses an aqueous hard surface cleaning composition wherein the composition includes an amine oxide, chelating agent, caustic component, a glycol ether solvent system having one glycol ether or glycol ether acetate solvent, and a caustic agent to ensure the overall pH of the compositions is at least 11.5 or greater. The Examiner also asserted that the broad teachings of Feng in combination with Culshaw et al and JP

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'597 would encompass compositions having the same flow viscosity, shear thinning properties, and other physical parameters as set forth by the Claims. The Examiner further alleged that the deficiencies of Feng are taught by JP '597, asserting that JP '597 discloses a liquid detergent composition containing a clay mineral having an average particle diameter of less than 100 nm and the other requisite components of the composition in the specific proportions as recited by the instant claims.

However, as will be set forth in detail below, it is submitted that the hard surface cleaning compositions as defined by Claims 38-55 and 57-66 are non-obvious over and patentably distinguishable from Feng in view of Culshaw et al and JP '597. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

The Applicants bring to the Examiner's attention that when prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight-gleaned from the invention itself. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). In other words, the invention must have been obvious at the time it was made; the Examiner cannot use hindsight to reconstruct the invention from the prior art and say the invention was obvious, *W.L. Gore*, 721 F.2d at 1553. To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As recited above, obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, supra; see also *Leinoff v. Louis Milona & Sons Inc.*, 726 F.2d 734, 739 (Fed. Cir. 1984). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys., Inc. v. Montefiore Hosp. et al*, supra; see also *Carella*, 804 F.2d at 140. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Therefore, "when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Beattie*.

Please note that Feng does not teach compositions having shear thinning properties. The courts have ruled in the case of *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.

The deficiencies of Feng with respect to Claims 38-55 and 57-66 are not resolved by either Culshaw et al or JP '597, alone or in combination. There is no such shear thinning property requirement in the any of the compositions of Culshaw et al or JP '597. Specifically, there is no

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motivation in Culshaw et al or JP '597 to direct one skilled in the art to prepare cleaning compositions having a highly alkaline pH (i.e. about 11.5) using particles having a platelet size of less than 100 nm containing a soil swelling agent, a smectite clay with a particle size of less than 100 nm, having the shear thinning properties, as asserted by the Examiner. Thus, considering the entirety of Culshaw and JP '597, one skilled in the art would not look to reference combinations that are absent motivation to provide shear thinning properties in preparing a cleaning composition according to the present claims.

By picking and choosing among individual elements of assorted parts of references, the Applicants submit that the Examiner has used hindsight to reconstruct the invention. Since, there is no motivation, suggestion or teaching in Feng, alone or in combination with Culshaw et al, or JP '597, of the desirability of providing shear thinning properties in their compositions, there can be no expectation of success. Thus, the Applicants do not believe that Feng in view of Culshaw et al and JP '597 renders independent Claims 38, 57, 59, and 66, and their dependent claims, obvious.

It is therefore submitted that the cleaning compositions as defined by Claims 38-55 and 57-66 are non-obvious over and patentably distinguishable from Feng in combination with Culshaw et al and JP '597, and the rejection of Claims 38-55 and 57-66 under 35 U.S.C. § 103 has been overcome. Reconsideration is respectfully requested.

B. Claim 56 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Culshaw et al in view of JP '597 or Feng in view of Culshaw et al and JP '597 as applied to the rejection of Claim 38, from which Claim 56 depends, and further in view of the Ofosu-Asante U.S. Patent 5,739,092 (hereinafter referred to as "Ofosu-Asante").

The Office Action admitted that none of the previously cited references taught the use of a divalent cation in addition to the other requisite components of the composition as recited in Claim 56. The Office Action relied on Ofosu-Asante as teaching a liquid or gel dishwashing detergent composition containing alkyl ethoxy carboxylate surfactant and calcium or magnesium ions, and that the presence of such calcium or magnesium ions can improve the cleaning of greasy soils for compositions, manifest mildness to the skin, and provide good storage stability.

However, as will be set forth in detail below, it is submitted that the hard surface cleaning composition as defined by Claim 56 is non-obvious over and patentably distinguishable from Culshaw et al, Feng and JP '597 in view of Ofosu-Asante. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

The deficiencies of Feng, Culshaw et al, and JP '597 are also not resolved by Ofosu-Asante. Ofosu-Asante is silent as to compositions that exhibit shear thinning properties. Ofosu-Asante broadly discloses a light-duty dishwashing detergent composition generally having an

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alkyl ethoxy surfactant, calcium or magnesium ions, and an alkylpolyethoxypolycarboxylate surfactant (col. 6, lines 60-65), having a pH range of from 7 to 11 (col. 5, lines 41-49), with a preferred pH range from 8.5 to 9.5. Furthermore, since Ofosu-Asante fails to teach or suggest shear thinning properties of its compositions, the Examiner cannot pick and choose among individual elements of assorted parts of references to recreate the claimed invention. The Examiner has some burden to show some teaching or suggestion in references and to support their use in the particular claimed combinations. *Smith-Kline Diagnostics, Inc. v. Helena Laboratories, Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988) (citation omitted). The Applicants find no teaching or suggestion in any of these references relating to hard surface cleaning compositions, having a pH, as measured in a 10% solution in distilled water, from about 11.5 to about 14, comprising a soil swelling agent, thickening system and a divalent cation, having shear thinning properties, as defined by Claim 56.

Since, there is no motivation, suggestion or teaching in Feng, Culshaw et al, JP '597, or Ofosu-Asante, alone or in combination, of the desirability of providing shear thinning properties in their compositions, there can be no expectation of success. It is therefore submitted that the cleaning compositions as defined by Claim 56 are non-obvious over and patentably distinguishable from Culshaw et al, Feng and JP '597 in combination with Ofosu-Asante and the rejection of Claim 56 under 35 U.S.C. § 103 has been overcome. Reconsideration is respectfully requested.

CONCLUSION

It is believed that the above remarks represent a complete response to the Examiner's rejections under 35 U.S.C. §§ 112 and 103, placing the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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